

Remarks

The examiner has rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,752 ("the '752 patent") in view of U.S. Patent No. 6,135,646 ("the '646 patent"). These rejections are respectfully traversed.

All of the claims require among other elements, at least one database containing a plurality of recordation forms accessible by said Internet server, software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property, and software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document.

The Examiner has submitted that the '752 patent (at 612, 626, 640, Fig. 6 and corresponding text) teaches at least one database containing a plurality of recordation forms accessible by said Internet server. Applicant respectfully disagrees. The '752 patent discloses "Document Databases 612", "BOM Databases 626" and "Notes Databases 640", however none of these correspond to a database containing a plurality of recordation forms. (Fig. 6) For instance, "the document databases 612 represent the customer's repository of documents" and also includes "electronic representations of other documents of interest to the customer, such as depositions, pleadings, and prior art references." (Col. 17, lines 5-6 and 28-30). None of these types of documents comprise a database containing a plurality of recordation forms, rather these are documents that relate to a specific intellectual property. In addition, BOM databases 626 does not comprise a database containing a plurality of recordation forms. Rather, the '752 patent teaches that a "BOM (bill of materials) group is a group that contains patents (and perhaps other documents) that map to a product, or that map to parts of a product." (Col.

20, lines 65-67). Nowhere does the '752 patent teach that the BOM (bill of materials) database 626 comprises a database containing a plurality of recordation forms. Additionally, the '752 patent teaches that "annotations, linkage information (i.e., information that specifies the link between a note and a portion of a document), and information related to the annotations and/or the linkage information ... are stored in the notes databases 640." (Col. 19, lines 1-7). Nowhere does the '752 patent teach that the notes databases 640 comprises a database containing a plurality of recordation forms. Applicant still further submits the '646 patent fails to teach, disclose or suggest a database containing a plurality of recordation forms as required by all the claims of the present invention.

Therefore, applicant respectfully submits that neither the '752 patent nor the '646 patent teach, disclose or suggest a database containing a plurality of recordation forms as required by all the claims of the present invention, and therefore no combination thereof can render any claim of the present application obvious.

The Examiner has further submitted that the '646 patent (at Col. 6, lines 32-52) teaches software for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request. Applicant respectfully disagrees. The '646 patent teaches that the "properties record may contain entries such as the identity of a rights management system 1018 (i.e., the system that has control over transfers of and compensation for right in that object), the handle 1012 for that object, the originator of the object 1020, the name of the object (if any) 1022, a description of any work or other information or material incorporated in the object 1024, the time and date of deposit 1026, format information 1028, and stated terms and conditions in the properties record may allow the user to select which type of action to allow (e.g. retrieve object or perform object)." (Col. 6, lines 32-43). This information cited by the Examiner in the '646 patent is not directed to a database of recordation forms, but rather is data specific to an object to be transferred.

The present application is directed toward a system for the transfer of intellectual property rights such as, patents, trademarks and copyrights. To legally transfer these types of intellectual property, specific transfer forms must be filed with, for instance, the United States Patent and Trademark Office. The database containing a plurality of recordation forms may include for instance, any of these standardized forms required to be filed with the United States Patent and Trademark Office. The system can then retrieve data specific to an intellectual property and then combine this information with a selected transfer form, which is selected according to the intellectual property to be transferred, to generate a transfer document.

Alternatively, the system claimed in the present application analyzes a property transfer request by a user, selects the proper transfer form from a database of recordation forms, and generates a property transfer document based upon combining a retrieved information record with a retrieved recordation form. The claims of the present application therefore, require two databases of information, one containing a plurality of information records (i.e. specific information relating to an intellectual property), and the other containing a plurality of recordation forms (i.e. standardized forms for transferring intellectual property). All the claims of the present application further require combining the retrieved information record (the specific information relating to the intellectual property) with the retrieved recordation form (the standardized form for transferring the intellectual property) to generate a document.

Still further, neither the '752 patent nor the '646 patent teach, disclose or suggest querying a database of recordation forms to retrieve a recordation form corresponding to said transfer request, and combining the retrieved information record with the retrieved recordation form to generate a document, as required by all the claims of the present application. Rather, the '646 patent teaches that a "registrar workstation 50 allows a registrar user to view and print rights registration applications and accompanying documents and recordation information and accompanying documents." (Col. 8, lines 47-50)(emphasis added). The '646 patent further teaches that the "workstation interacts

with the registration system to obtain registration application information, with the right management system and repositories to obtain digital objects whose rights are being registered, and with the recordation system to obtain recordation information and associated documents." (Col. 8, lines 50-55). Nowhere however, does the '646 patent teach that the system combines a retrieved information record with a retrieved recordation form to generate a document. Instead, the '646 patent teaches that the system allows a registrar user to view and print various documents, but nowhere does it teach that the system itself makes a selection of the appropriate form by retrieving the recordation form corresponding to the transfer request and then combines this selected form with a retrieved information record to generate a document, as required by all the claims in the present application.

Therefore, applicant respectfully submits that neither the '752 patent nor the '646 patent teach, disclose or suggest querying a database of recordation forms to retrieve a recordation form corresponding to said transfer request, and combining the retrieved information record with the retrieved recordation form to generate a document, as required by all the claims of the present invention, and therefore no combination thereof can render any claim of the present application obvious.

Applicant further respectfully submits that there is no motivation to combine these two references. For instance, while the '752 patent is directed toward a system for processing information related to patents, the '646 patent is directed toward a system for managing digital objects in a network such that the terms and conditions under which the digital objects are accessed by users are controlled. Nowhere does the '646 patent teach assigning the rights to a patent. For instance, assigning the rights to a patent requires filing of specific forms with the United States Patent and Trademark Office. The '646 patent fails to teach providing these forms to accomplish this transfer because it is not directed toward transferring patents.

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Applicant still further respectfully submits that one could come up with a number of inventions based upon the suggested combination. For instance, one could have arrived at a system that processes information related to a patent and allows for the physical transfer of a digital object that may be the subject of that patent. One however, could not arrive at a system that processes information related to a patent and further facilitates the assignment of the patent without using this application as a guide as neither of the cited references teach this transfer.

It is respectfully submitted that claims 1-10, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,


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